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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS AND INTERFERENCES

Appellant: Christopher S. Autterson
Serial No: 09/921,204
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Group Art Unit: 3728
Examiner: John G. Pickett
Title: ADVERTISING METHOD AND PRODUCT

APPEAL BRIEF

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REAL PARTY IN INTEREST

The real party in interest is Argent Automotive Systems, Inc., the assignee of record.

RELATED APPEALS AND INTERFERENCES:

None.

STATUS OF CLAIMS

Claim 1 (claim on appeal).

Claims 2-10 (cancelled).

Claim 11 (claim on appeal).

Claims 12-20 (cancelled).

STATUS OF AMENDMENTS

No amendment was filed subsequent to Final Rejection.

SUMMARY OF CLAIMED SUBJECT MATTER

The present invention provides a novel and unique method of advertising, comprising the steps of: providing a shipping/packaging container product, such as a carton; providing on a first predetermined area of said shipping/packaging container product a first advertisement of a first party owning said shipping/packaging container product; and providing on a second predetermined area of said shipping/packaging container product a second advertisement of a second party separate and distinct from said first party (spec. page 3, lines 8-14).

Claim 1 (claim on appeal) A method of advertising (spec. page 1, lines 7-9; spec. page 2, lines 17-21; spec. page 3, lines 8-14; spec. page 4, lines 2-18), comprising the steps of:

providing a corrugated or chipboard shipping/packaging carton (spec. page 4, lines 2-5; spec. page 6, line 14; spec. page 7, line 18; drawing reference character 1) having an outer surface (spec. page 5, lines 7-8, 15-16; spec. page 6, lines 5, 13-14; drawing reference characters 2-7) and an inner surface, said carton (drawing reference character 1) having the shape of a rectangular parallelepiped (spec. page 5, lines 9-11; drawing reference character 1);

visibly printing (spec. page 7, lines 17-19; drawing reference characters 12-17) directly on a first predetermined area (spec. page 5, lines 14-15; drawing reference characters 8-11) of said outer carton surface (drawing reference characters 2-7) of said shipping/packaging carton (drawing reference character 1) a first visible advertisement (spec. page 3, lines 11 & 18; page 5, lines 13-14; page 6, line 2; page 7, lines 17-19; drawing reference characters 12-17) for a first product (spec. page 5, line 21-page 6, line 1) of a first party (spec. page 5, lines 12-13) owning said shipping/packaging

visibly printing (spec. page 7, lines 17-19; drawing reference characters 20-33) directly on a second predetermined area (spec. page 3, lines 2-13; spec. page 6, lines 3-4; drawing reference characters 18 and 19) of said outer carton surface (drawing reference characters 2-7) of said shipping/packaging carton (drawing reference character 1) a second visible advertisement (spec. page 6, lines 6-9; spec page 7, lines 9-19; drawing reference characters 20-33) for a second product (spec. page 7, lines 6-8) of a second party (spec. page 2, line 20; spec. page 3, line 14; spec. page 4, line 12; spec. page 5, lines 6, 9, 16, 17, 19; spec. page 7, lines 1-2) separate and distinct (spec. page 2, line 21; spec. page 3, line 14; spec. page 6, line 7) from said first party (spec. page 5, lines 12-13; spec. page 6, lines 7-8), which second product (spec. page 7, lines 6-8) is not contained in or part of said carton (drawing reference character 1);

said first and second visible advertisements (drawing reference characters 12-17 and 20-33) are both visibly printed (spec. page 7, lines 10, 17) on said shipping/packaging carton (drawing reference character 1) at the same time (spec. page 7, lines 9, 10, 17, 18);

said second visible advertisement (drawing reference characters 20-33) is visibly printed (spec. page 7, lines 10, 17) on said second predetermined area (drawing reference characters 18 and 19) of said shipping/packaging carton (drawing reference character 1) which would otherwise be a blank area or void of any visible printed details (spec. page 4, lines 4, 8; spec. page 6, lines 12-15; spec. page 7, line 11);

said second predetermined area (drawing reference characters 18 and 19) is allotted by said first party (spec. page 7, lines 1-4, 14-16);

said second visible advertisement is provided by said second party to said first party without said first party buying said second visible advertisement (spec. page 7, lines 1-5);

said first party determines the size and location of said second visible advertisement on said shipping/packaging carton (spec. page 7, lines 3-5, 14-16);

said second visible advertisement is visibly printed in said otherwise blank area on a front, back, side, top or bottom of said shipping/packaging carton (spec. page 6, lines 3-15; spec. page 7, lines 9-11, 17); and

the size of said second visible advertisement is determined, at least in part, by the shipping/packaging carton size (spec. page 7, lines 1-4, 11-13).

The present invention also provides a novel and unique shipping/packaging container product, comprising: a shipping/packaging container body structure; a first predetermined area on said shipping/packaging container body structure having within said first predetermined area a first advertisement of a first party owning said shipping/packaging container; and a second predetermined area of said shipping/packaging container body structure having within said second predetermined area a second advertisement of a second party separate and distinct from said first party (spec. page 3, line 15-page 4, line 1).

Claim 11 (claim on appeal) A shipping/packaging carton (drawing reference character 1), comprising:

a corrugated or chipboard shipping/packaging carton (spec. page 4, lines 2-5; spec. page 6, line 14, spec. page 7, line 18; drawing reference character 1) having an outer surface (spec. page 5, lines 7-8, 15-16; spec. page 6, lines 5, 13-14; drawing reference characters 2-7) and an inner surface, said carton having the shape of a rectangular parallelepiped (spec. page 5, lines 9-11; drawing reference character 1);

a first predetermined area (spec. page 5, lines 14-15; drawing reference characters 8-11) of said outer carton surface (drawing reference characters 2-7) of said shipping/packaging carton

(drawing reference character 1) having within said first predetermined area (drawing reference characters 8-11) a first visible advertisement (spec. page 3, lines 11, 18; spec. page 5, line 13-spec. page 6, line 2; spec. page 7, lines 17-19; drawing reference characters 12-17) for a first product (spec. page 5, line 21-page 6, line 1) of a first party (spec. page 5, lines 12-13) owning said shipping/packaging carton (drawing reference character 1);

said second predetermined area (drawing reference characters 18 and 19) of said outer carton surface (drawing reference characters 2-7) of said shipping/packaging carton (drawing reference character 1) having within said second predetermined area a second visible advertisement (spec. page 6, lines 6-9; spec. page 7, lines 9-19; drawing reference characters 20-33) for a second product (spec. page 7, lines 6-8) of a second party (spec. page 2, line 20; spec. page 3, line 14; spec. page 4, line 12; spec. page 5, lines 6, 9, 16, 17, 19; spec. page 7, lines 1 and 2) separate and distinct from said first party (spec. page 2, line 21; spec. page 3, line 14, spec. page 6, line 7), which second product is not contained in or part of said carton (spec. page 4, lines 10-14; spec. page 6, lines 16-21);

said first and second visible advertisements (drawing reference characters 12-17, 20-33) are both visibly printed directly on said shipping/packaging carton (spec. page 7, lines 10, 17, 18);

said second visible advertisement is visibly printed directly on said second predetermined area of said shipping/packaging carton which would otherwise be a blank area void of any visible printed detail (spec. page 4, lines 4, 8; spec. page 6, lines 12-15; spec. page 7, line 11);

said second predetermined area (drawing reference characters 18-19) is allotted by said first party (spec. page 7, lines 1-4; 14-16);

said second visible advertisement is provided by said second party to said first party without said first party buying said second visible advertisement (spec. page 7, lines 1-5);

said first party determines the size and location of second visible advertisement on said shipping/packaging carton (spec. page 7, lines 3-5, 14-16);

said second visible advertisement is visibly printed directly in said otherwise blank area on a front, back, side, top or bottom of said shipping/packaging carton (spec. page 6, lines 3-15; spec. page 7, lines 9-11, 17); and

the size of said second visible advertisement is determined, at least in part, by the shipping/packaging container carton size (spec. page 7, lines 1-4, 11-13).

GROUND OF REJECTION TO BE REVIEWED ON APPEAL

1. Whether claim 1 is unpatentable under 35 USC 103 over Ford (US 2,054,596) in view of Zimmerman (US 2,362,181) and Jenniches (DE 27 23 357 A; PTO translation provided with the last OA).
2. Whether claim 11 is unpatentable under 35 USC 103 over Ford (US 2,054,596) in view of Zimmerman (US 2,362,181) and Jenniches (DE 27 23 357 A; PTO translation provided with the last OA).
3. Whether claim 11 is unpatentable under 35 USC 103 over Kapp (US 5,246,161) in view of Zimmerman (US 2,362,181).

ARGUMENT

1. Whether claim 1 is unpatentable under 35 USC 103 over Ford in view of Zimmerman and Jenniches.

The last OA alleges regarding claim 1, Ford provides a shipping/packing carton having the shape of a parallelepiped (Figure 1), and visibly printing directly on a first predetermined area of the outer carton surface of the shipping/packaging carton a first visible advertisement for a first product contained within the carton (as shown, Figures 1-4). (Underscoring added for emphasis).

In contrast, appellant respectfully submits that Ford does not disclose a shipping/packing carton, nor a shipping/packaging carton as alleged in the last OA.

In contrast, Ford discloses a box or carton for holding and enclosing a plurality of units of merchandise, and does not disclose a box or carton for shipping and packing. The Ford “invention pertains to boxes or cartons designed primarily to hold and enclose a plurality of units of merchandise of a fixed size and character, and from which one or more units may be removed, from time to time, the carton being again closed and restored to its position on the shelf from which it was withdrawn.” (Ford, col. 1, lines 1-7; underscoring added for emphasis).

Appellant respectfully submits that Ford does not disclose a shipping/packaging carton having an advertisement printed on the outer carton surface.

Appellant respectfully submits that Ford does not disclose an advertisement.

An “advertisement” is defined as: “1. The act of advertising. 2. A notice, such as a poster or a paid announcement in the print, broadcast, or electronic media, designed to attract public attention or patronage.” (The American Heritage Dictionary of the English Language, 4th Edition, © 2000 by Houghton Mifflin Company; <http://dictionary.reference.com/search?Q=advertisement>); or “a public

“promotion of some product or service” (WordNet 2.0, © 2000, Princeton University; <http://dictionary.reference.com/search?Q=advertisement>).

The word “advertising” means “the activity of attracting public attention to a product or business, as by paid announcements in the print, broadcast or electronic media,” (The American Heritage Dictionary of the English Language, 4th Edition, © 2000 by Houghton Mifflin Company; <http://dictionary.reference.com/search?Q=advertising>).

Accordingly, it is respectfully submitted that Ford does not disclose an advertisement. In contrast, Ford discloses a box for holding and enclosing a plurality of units of merchandise of a fixed size and character, wherein, in the case of piston rings, the box is marked “with the number of rings and the size thereof shown on one face of the box, as for example, 12 $\frac{3}{4}$ + .010 $\frac{1}{8}$, and such other matter as may be descriptive of the ring characteristics, as for instance the word ‘Compression’.” (Ford, col. 1, lines 19-23).

The last OA alleges that it would have been obvious to one of ordinary skill in the art at the time the invention was made to form the carton of Ford from a corrugated cardboard in order to improve container wall strength. Appellant respectfully traverses this.

With regard to claim 1, it is respectfully submitted that 35 USC 103 relates to a person having ordinary skill in the art to which the subject matter sought to be patented pertains. With regard to claim 1, the person of ordinary skill in the art is a person skilled in the art of methods of advertising, to which claim 1 relates.

Furthermore, it is respectfully submitted that one of ordinary skill in the art of methods of advertising (to which claim 1 relates) would not look to Ford’s box for holding a plurality of units of merchandise of a fixed size and character, nor to Zimmerman’s container having a readily accessible invoice envelope to avoid the inconvenience and unpleasantness of licking or otherwise pasting the

adhesive flaps disclosed in the relatively complicated invoice envelope attaching means employed prior to Zimmerman (Zimmerman, col. 1, lines 16-27).

The last OA also alleges that as to the first party owning said shipping/packaging carton, it would have been obvious to one of ordinary skill in the art at the time the invention was made for the first party to own the package so as to reduce the number of parties to which profit must be distributed. Appellant respectfully traverses this.

It is respectfully submitted that it would not have been obvious to one of ordinary skill in the art of methods of advertising for the first party to own the package so as to reduce the number of parties to which profit must be distributed, as alleged in the last OA.

The last OA gives no support for the conclusion that it would be obvious for the first party to own the package so as to reduce the number of parties to which profit must be distributed. Is the last OA contending that one of ordinary skill in the art of methods of advertising is also one of ordinary skill in the art of reducing the number of parties to which profit must be distributed? The test under 35 USC 103 relates only to one of ordinary skill in the art of the subject matter sought to be patented, and not to one of ordinary skill in multiple arts or all arts

The last OA concedes that Ford-Zimmerman lacks, or does not expressly disclose the provision of a second advertisement. This concession does not go far enough, and is misleading.

Appellant respectfully submits that not only does Ford-Zimmerman not expressly disclose the provision of a second advertisement; but it does not impliedly disclose the provision of a second advertisement.

The misleading aspect is that Ford-Zimmerman fails to disclose the provision of a first advertisement (as indicated above), and also fails to disclose a second advertisement. The number of rings in a box is not an advertisement.

The last OA alleges that Jenniches teaches visibly printing directly on a second predetermined area of the outer carton surface of the shipping/packaging carton a second visible advertisement for a second product of a second party separate and distinct from said first party, which second product is not contained in or part of the carton (see Derwent Abstract) (underscoring added for emphasis).

Appellant respectfully submits that Jenniches does not teach a shipping/packaging carton. In contrast, Jenniches teaches a pack of cigarettes.

The last OA further alleges it would have been obvious of one of ordinary skill in the art at the time the invention was made to provide the carton of Ford-Zimmerman with a second advertisement as taught by Jenniches in order to provide an additional source of income for the first party. Appellant respectfully traverses this.

It is respectfully submitted that it would not have been obvious to one of ordinary skill in the art of methods of advertising (to which subject matter of claim 1 is directed) to provide a carton (by combining the teachings of Ford and Zimmerman) with a second advertisement (bearing in mind that a carton of Ford-Zimmerman does not contain a first advertisement as indicated above) as taught by Jenniches in order to provide an additional source of income for the first party.

One of ordinary skill in the art of methods of advertising is not one of ordinary skill in the art of manufacturing or modifying cartons, and is not one of ordinary skill in the art of providing an additional source of income for the first party.

The last OA alleges it would have further been obvious to one of ordinary skill in the art to print the advertisements simultaneously in order to reduce the steps in manufacturing.

Thus, the last OA takes the position that one of ordinary skill in the art of methods of advertising would also be skilled in the art “to form the carton of Ford from corrugated cardboard in

order to improve container wall strength,” and also in the art “to reduce the number of parties to which profit must be distributed,” and also in the art “to provide an additional source of income for the first party,” and also in the art “to reduce the steps in manufacturing”. Appellant respectfully submits that this is contrary to 35 USC 103 which deals with what would be obvious to a person skilled in the art to which the claimed subject matter pertains, and not skilled in various other arts.

The law considers the artisan to have ordinary skill, and knowledge of all the prior art, in his or her field. It is respectfully submitted that the law does not consider the artisan to be an expert in the art of making profit, nor to be an expert in who owns components of an invention, etc.

Furthermore, the invention of claim 1 is classified in a very crowded art, and consequently, a very small step forward should be regarded as significant.

Also, the cited art lacks any suggestion that the references should be modified in a manner required to meet the claims.

Attention is also respectfully directed to the concept of lack of implementation. In particular, if the claim 1 invention were in fact obvious, those skilled in the art surely would have implemented it by now. The fact that those skilled in the art have not implemented the invention, despite its advantages, indicates that it is not obvious.

Also, none of the cited references are directed to a shipping carton that advertises the products of the owner or sender of the carton, as well as the products of another party. Jenniches does not disclose a shipping carton, but rather discloses a pack of cigarettes. Therefore, the claim 1 invention is contrary to the teachings of the cited art. In particular, the claim 1 invention goes against the grain of what the cited art teaches.

Furthermore, it is respectfully submitted that the last OA makes strained interpretations of the cited references which can only be made by hindsight.

Moreover, it is respectfully submitted that the claim 1 invention solves and is directed to a different problem than that of the cited references, and such different problem is solved by the features recited in the claim. *In re Wright*, 6 USPQ 2d. 1959.

Also, the cited references are from different fields than that of the claim 1 invention, and this factor weighs against their use in the rejection. *In re Oetiker*, 24 USPQ 2d 1443.

Moreover, the fact that the last OA resorts to three prior art references in an effort to allege the unpatentability of claim 1, is an indication in and of itself that the claim 1 invention is not obvious.

2. Whether claim 11 is unpatentable under 35 USC 103 over Ford in view of Zimmerman and Jenniches.

The last OA states as to claim 11, the carton of Ford-Zimmerman-Jenniches discloses the claimed invention by presentation (underscoring added for emphasis). The last OA makes no other statement to support a Ford-Zimmerman-Jenniches rejection of claim 11.

It is not clear what the last OA intends by the word “presentation”.

Furthermore, the last OA does not state that claim 11 would have been obvious to one of ordinary skill of the art in view of Ford, Zimmerman and Jenniches. In contrast, the last OA merely makes the one statement that as to claim 11, the carton of Ford-Zimmerman and Jenniches discloses the claimed invention by presentation. Appellant respectfully submits that this is an improper 35 USC 103 rejection. Also, 35 CFR 1.113(b) requires a final rejection to repeat or state all grounds of rejection, clearly stating the reasons in support thereof.

Furthermore, whatever the last OA means by presentation, appellant respectfully submits that the carton of Ford-Zimmerman-Jenniches does not disclose the claim 11 invention based on the arguments set forth above by appellant with respect to claim 1.

3. Whether claim 11 is unpatentable under 35 USC 013 over Kapp in view of Zimmerman

The last OA alleges that Kapp discloses a shipping/packaging container (10) with first advertisement (indicia on panel 14) in a first predetermined area and second advertisement (indicia on panel 12) in a second predetermined area. Underscoring added for emphasis.

Appellant respectfully traverses this.

Kapp does not disclose a shipping/packaging container.

In contrast, the Kapp “invention relates to a box having a collectible card forming part of a cover of the box and which is detachable from the box and detachable from a closure flap of the cover. The detachable collectible card can be stored in the box along with other collectible cards.” (Kapp col. 1, lines 5-10).

The last OA also alleges it would have been obvious to one of ordinary skill in the art to form the carton of Kapp from a corrugated cardboard in order to improve container wall strength. This is contrary to the teachings of Kapp which relates to a box for children to detach first portion 22, forming the majority of the cover as a collectible card, and another portion 24, forming a minority of the cover, a closure flap which fits into the interior of the formed box so as to close the box. (Kapp col. 2, lines 38-43).

Thus, it would be contrary to the teachings of Kapp to use corrugated cardboard to improve container strength when the purpose of Kapp is to present a detachable collectible card which forms part of the cover and a closure flap which fits into the interior of the box so as to close the box.

Moreover, Kapp states that “the box is made of thin cardboard or reinforced paper” and requires a collectible card 22 which is detachable from the remainder of the box along perforated score line 26 located on one edge of the card. Kapp col.2, lines 37, 47-50. Thus, it would be contrary to the teachings of Kapp to reinforce the Kapp box with corrugated cardboard.

The last OA concedes that Kapp-Zimmerman does not disclose the specific arrangement and/or content of indicia (printed matter) set forth in claim 11. However, the last OA states it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the indicia in the claimed arrangement and content since it would only depend on the intended use of the assembly and the desired information to be displayed.

In contrast, appellant respectfully submits that *In re Gulack*, 217 USPQ 401, 403 (CAFC 1983) states:

“Differences between an invention and the prior art cited against it cannot be ignored merely because those differences reside in the content of the printed matter. Under Section 103, the Board cannot dissect the claim, excise the printed matter from it, and declare the remaining portion of the mutilated claim to be unpatentable. The claim must be read as a whole”. (Underscoring added for emphasis).

Attention is also respectfully directed to Footnote 8 of *In re Gulack* which states:

“A ‘printed matter rejection’ under § 103 stands on questionable legal and logical footing. Standing alone, the description of an element of the invention as printed matter tells nothing about the differences between the invention and the prior art or about whether that invention was suggested by the prior art. A printed matter rejection is based on case law antedating the 1952 patent act, employing a point of novelty approach. *In re Sterling*, 70 F.2d 910, 21 USPQ 519 (CCPA 1934). The 1952 act legislatively revised that approach through its requirement that the claim be viewed as a whole in determining obviousness. *Graham v. John Deer Co.*, 382 U.S. 1, 148 USPQ 459 (1966). The CCPA has considered *all* of the limitations of the claims including the printed matter limitations, in determining whether the invention would have been obvious. See *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974); *In re Cavrich*, 451 F.2d 1091, 172 USPQ 121 (CCPA

1971). In *Royka*, 490 F.2d at 985, 180 USPQ at 5583, the CCPA, notably weary of reiterating this point, clearly stated that printed matter may well constitute structural limitations upon which patentability can be predicted”.

In addition, attention is also respectfully directed to Footnote 9 of *In re Gulack*, which states:

“35 USC § 103 (1976) specifically provides that: ‘A patent may not be obtained *** if the differences between the subject matter sought to be patented and the prior art are such that *the subject matter as a whole* would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains *** (Emphasis supplied.) See *Graham*, 383 U.S. 1, 148 USPQ 459; *Flook*, 437 U.S. at 594 n. 16, 198 USPQ at 199 n. 16 (noting the § 103 requirement of reading claims as a whole and extending that requirement to § 101); *Diamond v Diehr*, 450 U.S. 175, 188, 209 USPQ 1, 9 (1981) (also applying that requirement in a § 101 setting); *Royka*, 490 F.2d at 985, 180 USPQ at 583”.

The last OA alleges that it has been held that a recitation with respect to the manner in which the claimed apparatus is intended to be employed does not differentiate the claimed apparatus from the prior art apparatus satisfying the claimed structural elements. Appellant respectfully traverses this contention.

First, here the cited art apparatus does not satisfy the claimed structural elements, as shown above by appellant.

Secondly, *In re Miller*, 164 USPQ 46, 48, states:

“[I]t seems to us that what is significant here is not structural but *functional* relationship ***.*** As for the examiner’s characterization of the indicia and legend as ‘unpatentable printed matter,’ we note that the examiner himself recognizes that fact that printed matter, in an article of manufacture claim, *can* be given ‘patentable weight.’ He did so in allowing claims. His

characterization of printed matter as ‘unpatentable’ is beside the point; no attempt is here being made to patent printed matter as such. The fact that printed matter *by itself* is not patentable subject matter, because non-statutory, is no reason for ignoring it when the claim is directed to a combination.”

Furthermore, appellant respectfully submits that the presence or absence of a specific functional relationship is not dispositive of obviousness. What must be looked at to determine patentability is the existence of differences between the claim and the prior art. There is no suggestion in Kapp-Zimmerman of the features specified in claim 11. These features constitute the differences between claim 11 and the prior art which are sufficient to establish patentability.

In re Gulack, 217 USPQ 401, 404, states:

“Similarly, in examining Gulack’s invention, we find that a functional relationship does exist between the printed matter and the substrate. A functional relationship of the precise type found by the CCPA in Miller – to size or to type of substrate, or conveying information about substrate – is not required. What is required is the existence of *differences* between the appealed claims and the prior art sufficient to establish patentability. The bare presence or absence of a specific functional relationship, without further analysis, is not dispositive of obviousness. Rather, the critical question is whether there exists any new and unobvious functional relationship between the printed matter and the substrate”.

With regard to all three obviousness rejections stated in the last OA, it is respectfully submitted that the PTO has not met its burden of setting forth a prime facie case of obviousness because there is no explanation in the last OA (other than the hindsight knowledge after having been exposed to the the appellant’s application) as to:

why it would have been obvious to one of ordinary skill in that particular art to have a first party also own the shipping/packaging carton to reduce the number of parties to which profit must be distributed; nor

why it would have been obvious to one of ordinary skill in that particular art to provide a second advertisement of a second party separate and distinct from the first party; nor

why it would have been obvious to a person skilled in that particular art for the first party to allot the area for a second party's advertisement, and determine the size and location of the second party's advertisement; nor

why it would have been obvious to one of ordinary skill in that particular art to place a second advertisement on an area of a corrugated or chipboard shipping/packaging carton that would otherwise be blank.

Up to now those skilled in the art thought or found the problem of unused space on shipping cartons (which is solved by the present invention) to be insoluble. Thus, the present invention converts failure into success. The failures of prior art workers indicate that a solution was not obvious.

Moreover, appellant's invention solves and is directed to a different problem than that of the cited references, and such different problem is solved by the features recited in claims 1 and 11. *In re Wright*, 6 USPQ 2d. 1959.

CLAIMS APPENDIX

1. A method of advertising, comprising the steps of:

providing a corrugated or chipboard shipping/packaging carton having an outer surface and an inner surface, said carton having the shape of a rectangular parallelepiped;

visibly printing directly on a first predetermined area of said outer carton surface of said shipping/packaging carton a first visible advertisement for a first product of a first party owning said shipping/packaging carton;

visibly printing directly on a second predetermined area of said outer carton surface of said shipping/packaging carton a second visible advertisement for a second product of a second party separate and distinct from said first party, which second product is not contained in or part of said carton;

said first and second visible advertisements are both visibly printed on said shipping/packaging carton at the same time;

said second visible advertisement is visibly printed on said second predetermined area of said shipping/packaging carton which would otherwise be a blank area or void of any visible printed details;

said second predetermined area is allotted by said first party;

said second visible advertisement is provided by said second party to said first party without said first party buying said second visible advertisement;

said first party determines the size and location of said second visible advertisement on said shipping/packaging carton;

said second visible advertisement is visibly printed in said otherwise blank area on a front, back, side, top or bottom of said shipping/packaging carton; and

the size of said second visible advertisement is determined, at least in part, by the shipping/packaging carton size.

11. A shipping/packaging carton, comprising:

a corrugated or chipboard shipping/packaging carton having an outer surface and an inner surface, said carton having the shape of a rectangular parallelepiped;

a first predetermined area of said outer carton surface of said shipping/packaging carton having within said first predetermined area a first visible advertisement for a first product of a first party owning said shipping/packaging carton;

a second predetermined area of said outer carton surface of said shipping/packaging carton having within said second predetermined area a second visible advertisement for a second product of a second party separate and distinct from said first party, which second product is not contained in or part of said carton;

said first and second visible advertisements are both visibly printed directly on said shipping/packaging carton;

said second visible advertisement is visibly printed directly on said second predetermined area of said shipping/packaging carton which would otherwise be a blank area or void of any visible printed detail;

said second predetermined area is allotted by said first party;

said second visible advertisement is provided by said second party to said first party without said first party buying said second visible advertisement;

said first party determines the size and location of said second visible advertisement on said shipping/packaging carton;

said second visible advertisement is visibly printed directly in said otherwise blank area on a front, back, side, top or bottom of said shipping/packaging carton; and

the size of said second visible advertisement is determined, at least in part, by the shipping/packaging carton size.

EVIDENCE APPENDIX

None.

RELATED PROCEEDINGS APPENDIX

None.

REQUEST FOR ORAL HEARING

None.

CONCLUSION

For the foregoing reasons, appellant submits that the rejection of claims 1 and 11 is in error and should be reversed.

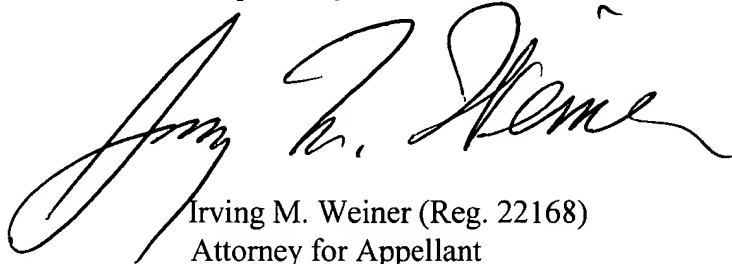
This Appeal Brief is accompanied by an Appendix which presents a clean copy of the claims involved in the appeal.

Appellant encloses herewith a form PTO-2038 for the Appeal Brief fee.

Appellant further encloses a Petition for Extension of Time and a form PTO-2038 for the petition fee

Favorable consideration and reversal of the Final Rejection are earnestly requested.

Respectfully submitted,

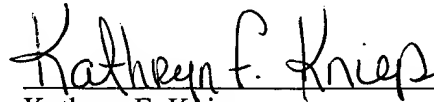


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Certificate of Mailing

I hereby certify that the foregoing Appeal Brief and its enclosures were mailed to Mail Stop Appeal Brief - Patents, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on December 6, 2005 by first class mail with sufficient postage to cover the cost.


Kathryn F. Knierp